

REMARKS

Claim Rejections

Claims 12 and 13 are rejected under 35 U.S.C. § 112, second paragraph. Claims 11 and 14 are rejected under 35 U.S.C. § 102(e) as being anticipated by Howard et al. (U.S. 2002/0069365). Claims 12 and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Howard et al. in view of Candelore (U.S. 6,697,489). Claim 13 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Howard et al.

It is noted that the reference to Howard et al. and Candelore were initially cited by the Examiner in the outstanding Final Office Action. Thus, this Amendment represents Applicant's initial opportunity to respond to the rejections based upon these references.

Drawings

It is noted that the Examiner has previously accepted the drawings as originally files with this application.

Claim Amendments

By this Amendment, Applicant has canceled claims 11 and 14-16 and has amended claims 12 and 13 of this application to obviate the outstanding rejections under 35 U.S.C. 112. It is believed that the amended claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

The primary reference to Howard et al. teaches a limited-use browser and security system including connecting a computer (121, 125, 135, 137) to a web server (109).

On page 6 of the outstanding Office Action, the Examiner admits that "Howard does not explicitly disclose the data is music data and the access device is an MP3 music player playing the music data."

On page 8 of the outstanding Office Action, the Examiner admits that "Howard does not explicitly disclose wherein the encrypting step c) the data is an electronic book and the access device is an electronic book player playing the contents of the electronic book."

Howard et al. do not teach connecting an MP3 player to a subscriber's end of a network; encrypting music data on the network to create encrypted data; connecting an electronic book player to a subscriber's end of a network; nor do Howard et al. teach encrypting an electronic book on the network to create encrypted data.

It is axiomatic in U.S. patent law that, in order for a reference to anticipate a claimed structure, it must clearly disclose each and every feature of the claimed structure. Applicant submits that it is abundantly clear, as discussed above, that Howard et al. do not disclose each and every feature of Applicant's amended claims and, therefore, could not possibly anticipate these claims under 35 U.S.C. § 102. Absent a specific showing of these features, Howard et al. cannot be said to anticipate any of Applicant's amended claims under 35 U.S.C. § 102.

The secondary reference to Candelore teaches a method and apparatus for securing control words and is cited for teaching downloadable audio-visual files, such as MP3-formatted audio files.

Candelore does not teach connecting an MP3 player to a subscriber's end of a network; encrypting music data on the network to create encrypted data; connecting an electronic book player to a subscriber's end of a network; nor does Candelore teach encrypting an electronic book on the network to create encrypted data.

Even if the teachings of Howard et al. and Candelore were combined, as suggested by the Examiner, the resultant combination does not suggest: connecting an MP3 player to a subscriber's end of a network; encrypting music data on the network to create encrypted data; connecting an electronic book player to a subscriber's end of a network; nor does the combination suggest encrypting an electronic book on the network to create encrypted data.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Howard et al. or Candelore that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Howard et al. nor Candelore disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's amended claims.

Summary

In view of the foregoing, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should the Examiner not be of the opinion that this case is in condition for allowance, it is requested that this amendment be entered for the purposes of appeal, since it materially reduces the issues on appeal by cancelling claims 11 and 14-16, thereby rendering moot the outstanding rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103.

It is not believed that the foregoing amendments to claims 12 and 13 require any further searching and/or consideration on the part of the Examiner, since such amendment merely includes incorporating the language of canceled claim 11 into each of claims 12 and 13. Thus, the Examiner would have inherently searched this subject matter during the previous consideration of claims 11-13.

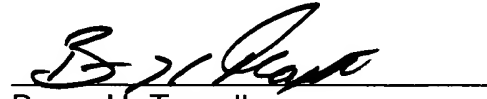
Application No. 09/865,714

Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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